

REMARKS

Status Summary

Claims 43-78 are pending in the present application, of which claims 43 and 61 are presented in independent form. No claims have been allowed and claims 43-78 stand rejected.

Interview

Applicant wishes to thank the Office for the courtesy extended during a telephonic interview with the undersigned representative on July 1, 2008. During the interview, an amendment to claims 43 and 61 as presented herein was discussed with reference to the currently cited art. Agreement was reached that the amendment to claims 43 and 61 as presented herein likely distinguishes the claims from the cited art and therefore likely overcomes the 35 U.S.C. § 102 rejections of the previous Official Action, as reiterated further below. Additionally, the amendment of claim 61 and the amendment to the specification overcomes the 35 U.S.C. § 101 and § 112 rejections of claims 61-78.

Claim Rejection(s) - 35 U.S.C. § 101

Claims 61-78 stand rejected under 35 U.S.C. § 101, for being directed to non-statutory subject matter. Claim 61 had been amended as suggested by the Examiner. The Examiner is thanked for the suggestion. In view of the amendment, it is respectfully requested that the 35 U.S.C. § 101 of claims 61-78 be withdrawn.

Claim Rejection(s) - 35 U.S.C. § 112

Claims 61-78 stand rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action states that it is unclear as to

what Applicant regards as a "computer-readable medium."

The term "computer-readable medium," has a well known meaning in this art. In accordance with MPEP 2111.01(II), "[t]he ordinary and customary meaning of a claim term is the meaning that a term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the application." (Citing Philips v. AWH Corp., 75 USPQ 2d 1321 (Fed. Cir. 2005)). As is known in this art, a "computer-readable medium" can include one or more of any suitable media for storing the executable instructions of a computer program in one or more of an electronic, magnetic, optical, and electromagnetic form, such that the instruction execution machine, system, apparatus, or device can read (or fetch) the instructions from the computer readable medium and execute the instructions for carrying out the described methods. A non-exhaustive list of conventional exemplary computer readable medium includes: a portable computer diskette; a random access memory (RAM); a read only memory (ROM); an erasable programmable read only memory (EPROM or Flash memory); optical storage devices, including a portable compact disc (CD), a portable digital video disc (DVD), and the like.

Here the claim terminology in question is as originally filed and was not presented late in prosecution. Nevertheless, the specification has been amended to include antecedent basis for the term computer-readable medium based on the ordinary and customary meaning known in the art, as described above.

In view of the foregoing, it is respectfully requested that the 35 U.S.C. § 112 rejection of claims 61-78 be withdrawn.

Claim Rejection(s) - 35 U.S.C. § 102

Claims 43, 47-57 and 61-78 stand rejected as being anticipated by U.S. Patent No. 7,117,519 to Anderson, et al. (hereinafter "Anderson"). This ground of rejection is respectfully traversed.

Independent claims 43 and 61 have been amended to more clearly define the subject matter being claimed. Claim 43 as amended requires the features of in response to a user configuring an action list on the computer by mapping one or more user input events detectable on the portable image capture device to one or more file handling actions on the at least one stored file, downloading the action list from the computer to the portable image capture device; and performing, on the at least one stored file included in the portable image capture device, the corresponding file handling action within the portable image capture device when an input event on the portable image capture device is detected that matches one of the user input events in the action list. Claim 61 as amended requires the features of downloading an action list from a computer to the portable image capture device, the action list comprising a mapping of one or more user input events on the portable image capture device to one or more file handling actions on the at least one stored file; and performing, on the file, a corresponding file handling action within the portable image capture device when an input event is detected on the portable image capture device that matches one of the events in the downloaded action list.

Anderson et al. discloses actions to be taken by a server when the images are uploaded to the server from a handheld image capture device. See the abstract of Anderson et al. The claims, as amended, require that actions be performed on a stored file in the portable image capture device. It is therefore respectfully submitted that Anderson teaches away from the features of independent claims 43 and 61 and therefore does not teach all of the features of the claims. It is therefore respectfully submitted that the rejection of claims 43 and 61 be withdrawn.

Claims 45-57 add 62-78 depend from claims 43 and 61, respectively, and are believed to patentable for at least the same reasons set forth for claims 43 and 61.

With respect to claim 50, Anderson does not disclose a list of supported user interface input events specific to the user's type of device for the user to select a desired set of input events. Column 8, lines 7-12 of Anderson teach that each user

account in a database may have one or more action lists representing actions the server should take with respect to uploaded images. Clearly, these actions are specific to the server and are not specific to the user's type of device.

With respect to claim 51, Anderson discloses a set of actions that can be performed on the server. Anderson does not teach displaying a set of actions that can be performed on the portable image capture device when each selected event occurs for the user to map one or more actions to each event.

With respect to claims 63-78, the cited section of Anderson (Col 5, Line 64 - 67 to Col 6, Line 1 – 49) teaches downloading software that allows the device of Anderson to communicate over the Internet and for accepting a software application that specifies the entity ID's. The cited section does not teach or suggest any of the features of claims 63-78.

In view of the foregoing, it is respectfully submitted that Anderson does not teach or suggest all of the features of claims 47-57 and 62-78. It is therefore respectfully requested that the rejection of claims 47-57 and 62-78 be withdrawn.

Claim Rejection(s) - 35 U.S.C. § 103

Claims 44-46 and 56-60 stand rejected as being unpatentable over U.S. Patent No. 7,117,519 to Anderson, et al. (hereinafter "Anderson"), in view of U.S. Patent No. 7,283,158 to Shiohara, et al. (hereinafter "Shiohara").

As indicated above, Anderson does not teach or suggest all of the limitations of claim 41. Shiohara does not teach or suggest all of the features of claim 41. Therefore, neither Anderson or Shiohara teach or suggest, singly or in combination, all of the features of claim 41. Claims 44-46 and 56-60 depend from claim 41 and are believed to be patentable for at least the same reasons set forth for claim 41. It is therefore respectfully requested that the rejection of claims 44-46 and 56-60 be withdrawn.

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CONCLUSION

In view of the above, it is respectfully submitted that the present application is now in proper condition for allowance, and an early notice to such effect is earnestly solicited. The absence of additional patentability arguments should not be construed as either a disclaimer of such arguments or that such arguments are not believed to be meritorious. The Examiner is respectfully requested to telephone the undersigned patent attorney at the below-listed number if, after reviewing the above Remarks, the Examiner believes outstanding matters remain that may be resolved without the issuance of a subsequent Official Action.

DEPOSIT ACCOUNT

The Commissioner is hereby authorized to charge any additional fees, or credit any overpayment, associated with the filing of this paper to Deposit Account No. 50-3512.

Respectfully submitted,

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